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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,478	12/28/2001	Chad Gross	20338/301	2176

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EXAMINER

PITARO, RYAN F

ART UNIT PAPER NUMBER

2174

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,478

Applicant(s)

GROSS ET AL.

Examiner

Ryan F Pitaro

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 are pending.
2. This action is responsive to the communication filed on 4/05/2005. This action is made final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Spears ("Spears", US# 2002/0128879).

As per independent claim 1, Spears discloses a method for presenting personalized content to a user of a website, comprising: accepting a login identifier from the user ([0092] lines 1-2); querying a database for a first set of content, function of the login identifier ([0092] lines 7-10); wherein the first set of content is a querying the database for a second set of content, wherein the second set of content is a function of the employer for which the user is employed ([0089] lines 6-8; *depending on the employer*); and displaying the first set of content and the second set of content to the user through a web browser ([0088] lines 6-8).

As per claim 2, which is dependent on claim 1, Spears discloses a method wherein the first set of content is information on the benefits election for the user ([0092] lines 7-10).

As per claim 3, which is dependent on claim 1, Spears discloses a method wherein the second set of content is information on the benefits package of the employer ([0089] lines 9-13).

As per claim 4, which is dependent on claim 1, Spears discloses a method further comprising displaying to the user a third set of content (Figure 18); wherein the first set of content and the second set of content is information on plans administered by a plan administrator controlling the website (Figure 17; Aetna); and wherein the third set of content is information on plans not administered by the plan administrator (Figure 18; *wherein user designs his/her own benefit design*).

As per claim 5, which is dependent on claim 1, Spears discloses a method wherein the first set of content and the second set of content are used to generate a dynamic webpage ([0089] lines 3-6).

As per claim 6, which is dependent on claim 5, Spears discloses a method wherein the dynamic webpage aggregates information from various sources (Figure 1).

As per claim 7, which is dependent on claim 1, Spears discloses generating a dynamic profile based on the login identifier ([0122] lines 1-8)); and sending a secure email message from the user to a customer support representative ([0148] lines 4-7; *wherein email is a common means of communication*), wherein data from the dynamic profile is available to the customer support representative (Figure 1; *wherein customer*

service is internal and has access to all databases including the personal profile database).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spears ("Spears", US# 2002/0128879).

As per claim 8, which is dependent on claim 8 Spears fails to expressly point out not having to re-authenticate after logging in. However, Official Notice is taken that it is notoriously well known in the art that after logging in no authentication of data is needed to send an email. Examples of which are: Logging onto a network such as a Windows environment and accessing the email client such as Outlook, wherein the user does not have to log in again to send an email since the user has been authenticated a first time. Therefore it would have been obvious to combine the method of Spears with the current teaching. Motivation to do so would have been not to burden the user with multiple logins speeding up the use of the application.

Response to Arguments

The Affidavit filed on April 5, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Spears reference.

After carefully reviewing the affidavit, the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date, August 21, 2000, of the Spears, Pub US# 2002/0128879 reference. In this particular instance, there are no factual assertions sufficient to show the claimed subject matter. For instance, Applicant's exhibit lacks the claim limitation of claim 1, which states "...accepting a login identifier from the user; querying a database for a first set of content, wherein the first set of content is a function of the login identifier; querying the database for a second set of content, wherein the second set of content is a function of the employer for which the user is employed; and displaying the first set of content and the second set of content to the user through a web browser." The supporting exhibits are generic statements of work and progress timelines, which have no indication of what is being developed. Thus there is no connection with the claimed invention, which can be seen from the exhibits. Under 37 CFR 1.131 each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show (MPEP 715.07). The exhibits shown do not give a clear explanation of how the exhibits support the claimed invention.

Applicant is also reminded of who may make affidavit or declaration (MPEP 715.04). Affidavits of declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claims, or the assignee when it is not possible to produce the affidavit or declaration of the inventors. Thus, where all of the named inventors of a pending application are not inventors of

Art Unit: 2174

every claim of the application m, any affidavit under 37 CFR 1.131 could be signed by only the inventors of the subject matter of the rejected claims. Further where it is **shown** that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient (emphasis added). In this case a mere statement that the four applicants no longer work at Benesight and therefore they are not available to sign this declaration is insufficient to **show** a refusal to sign or he/she is unavailable to be reached to sign (emphasis added).

Furthermore, the Office notes that applicant did not contest the factual assertion set forth under Official Notice in claim 8 of pages 4-5 of the Office Action dated 12/16/2004.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F Pitaro whose telephone number is 571-272-4071. The examiner can normally be reached on 7:00am - 4:30pm M-Th, and alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan Pitaro
Patent Examiner
Art Unit 2174

RFP

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